

REMARKS

Reexamination and reconsideration of the application as amended are requested. Support for the amended claims is found in figure 2.

The examiner's rejection of claims 16-26 as being "obvious", under 35 U.S.C. 103, is respectfully traversed. The examiner rejects these claims as being unpatentable over Wulff (US 5,632,361) in view of Keil (US 6,382,372). Claims 17-18 depend from claim 16 and claims 20-25 depend from claim 19. Independent claims 16, 19 and 26 require that the inner tube 12 have a sidewall and that the entire sidewall be imperforate.

The examiner alleges that Wulff has "... an inner tube 12 with a first end and a second end having an imperforate sidewall ... ". Either the examiner is stating that the second end of the inner tube of Wulff has an imperforate sidewall or that both the first and second ends of the inner tube of Wulff have imperforate sidewalls. Neither possibility is a statement that Wulff discloses an inner tube having a sidewall, wherein the entire sidewall is imperforate, as required by applicants' claims 16, 19, and 26. Also, since the inner tube 12 of Wulff is only shown in figure 1 and is shown with most of the sidewall of the inner tube 14 (including its first and second ends) covered by the outer tube 4, Wulff discloses nothing about whether its entire sidewall of the inner tube is imperforate, as required by applicants claims 16, 19 and 26, or whether one or both of the ends of its inner tube (4) have imperforate sidewalls.

The examiner, in a previous office action, took the position that the inner tube 12 of the magnetorheological twin-tube damper 1 embodiment of figure 1 of Wulff has an imperforate sidewall on the grounds that, "If there was an orifice the inventor would have depicted it in the figure." The examiner took this position even though most of the sidewall of the inner tube 12 is hidden (or otherwise not shown) in figure 1. The examiner took this position even though the inner tube 202 (Wulff calls it a pressure pipe) of the shock absorber embodiment of figure 10 of Wulff does not have an imperforate sidewall but has an orifice 210 (see fig. 10 and column 6, line 47). The examiner took this position even though there is no teaching anywhere in Wulff

that the sidewall of any inner tube embodiment is imperforate and there is a teaching in figure 10 of Wulff of an inner tube embodiment with a sidewall having an orifice. The examiner took this position even though the examiner, in the previous office action, cited the Jensen patent in rejecting claim 15 (now canceled), wherein column 6, lines 49-51 of Jensen states, "... fluid communication is provided between a chamber 46 below the cylinder end 44 and the reservoir 40", and wherein no figure in Jensen shows any orifice providing fluid communication between the chamber 46 and the reservoir 40.

Applicants argue that the examiner's present or previous reasoning does not support the examiner's conclusions, and that the examiner has failed to show a prior art teaching of an inner tube of a magnetorheological damper having a sidewall, wherein the entire sidewall is imperforate, as required by applicants' claims 16, 19 and 26 (from which all of applicants' other claims depend).

The examiner alleges that Wulff discloses a magnetorheological damper comprising an inner tube 12 and a valve 207. Applicants respectfully disagree. Wulff discloses two dampers, wherein the first damper is shown in figures 1-9 and has an inner tube 12 (only a small portion of its sidewall being shown and with no valve being shown), and wherein the second damper is shown in figure 10 and has an inner tube 203 with a hole 210 in its sidewall and has a valve 207.

The examiner takes the bottom valve subsidiary component 207 of the figure 10 shock absorber embodiment of Wulff and adds it to the figure 1-9a damper embodiment of Wulff to come up with a magnetorheological damper not disclosed in Wulff. The examiner does this even though Wulff teaches (see column 6, lines 27-30) only that a figure 10 component may, if appropriate, be considered to be interchangeable with a figure 1-9a component and even though the figure 10 bottom valve cannot appropriately replace any component in the figure 1-9a damper embodiment. Adding a new figure 10 component (e.g., the bottom valve) to figure 1 is not found in, and appears contrary to, the teaching of Wulff who teaches only component replacement of a figure 1-9a component with an appropriate figure 10 component.

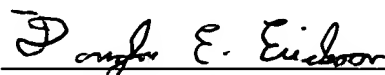
The examiner's previous reasoning for adding the figure 10 bottom valve to figure 1 is that, "The present invention is seen as figure 1 and the bottom valve is used as a subsidiary

component in figure 1” and that “column 3, line 25 states, ‘subsidiary components, including a bottom valve, with which the present invention could be employed’ ”. The complete sentence of the column 3, line 25 citation is, “FIG. 10 illustrates a shock absorber having subsidiary components, including a bottom valve, with which the present invention could be employed.” The invention of Wulff is the addition of a permanent magnet 6 to the piston 3 (see column 1, lines 46-49 and figures 1-5). This means that the figure 10 shock absorber could employ the figure 1 invention (i.e., figure 10 could add a permanent magnet to the piston 203), that the figure 10 shock absorber has subsidiary components in addition to the figure 1-9 invention components, and that such subsidiary components include a bottom valve. Wulff, in this citation, is not teaching that a subsidiary component of figure 10 can be used in figure 1. Elsewhere (see the previous paragraph), Wulff does teach that a figure 10 component can replace an appropriate figure 1 component (such as a figure 10 outer tube replacing a figure 1 outer tube). Adding a figure 10 subsidiary component (i.e., a component found in figure 10 but not in figure 1) to figure 1 is not found in, and appears contrary to, the teaching of Wulff who teaches that the figure 10 shock absorber contains the figure 1-9 invention and that (from the previous paragraph) a figure 1-9 component can be replaced by an appropriate figure 10 component. Applicants argue that the Examiner has failed to show a prior art teaching of a valve providing fluid communication of the outer tube with the inner tube in a magnetorheological damper having a sidewall, wherein the entire sidewall is imperforate, as required by applicants’ claims 1, 19 and 26.

It is clear that the patents cited by the examiner, taken alone or in combination, do not teach, suggest, or describe the subject matter of applicants' claimed invention.

Inasmuch as each of the rejections has been answered by the above remarks, it is respectfully requested that the rejections be withdrawn, and that this application be passed to issue.

Respectfully submitted,


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Amendment

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